

REMARKS

This is intended as a full and complete Response to the Office Action dated November 10, 2004, having a shortened statutory period for response set to expire on February 10, 2005. Claims 1-24, 35-55, 57-62, and 64-69 remain pending after entry of this response. No new matter has been introduced. Please reconsider the claims pending in the application for reasons discussed herein.

35 U.S.C. § 103

Claims 1-24, 35-55, 57-62, and 64-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kelly*, U.S. Patent No. 3,881,375 in view of *Swoboda*, U.S. Patent No. 3,840,128. The Examiner states *Kelly* discloses an apparatus for positioning a wellbore tong and all of the limitations of the claims except for the boom being cantilevered and extendable via an actuating member. The Examiner further states *Swoboda* discloses an apparatus for moving a wellbore tubular gripping member similar to the apparatus of *Kelly*. The Examiner states that *Swoboda* suggests "the desirability to be able to move a tong to any desired position on a drill rig." The Examiner concludes that it would have been obvious to one of ordinary skill in the art to have modified *Kelly* to include the extendable boom of *Swoboda*.

In order to establish a prima facie case of obviousness based on the prior art, the Examiner must show some "objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *Id.* at 1783-84. Moreover, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Id.* at 1784.

Kelly discloses an apparatus for positioning a tong assembly T vertically with respect to joints of a string of drill pipe. (See, column 2, Ins. 47-50) The apparatus includes a vertical column with a tong support structure extending horizontally therefrom. (See, column 2, Ins. 51-64) The tong support structure is adapted to move the tong upwardly and downwardly along the column. (See, column 2, Ins. 61-64) However, the tong support structure is fixed in length, and therefore, does not extend or retract the tong to and from the well center. Instead, *Kelly* discloses rotating the tong support structure on a vertical axis, thereby swinging the tong to and away from a position aligned with the wellbore along a fixed radius.

Swoboda discloses a racking arm having a pipe gripping head secured to an end of the arm. (See, column 2, Ins. 36-44) The racking arm guides movement of wellbore tubulars from various storage positions to a wellbore center. The gripping head may clamp the tubular for lateral movement while allowing the tubular to slide vertically along their axis, or to tightly grip the tubular for transportation. *Swoboda* does not teach making up or breaking out a tubular joint at well center. Rather, *Swoboda* is concerned with movement of the tubular to and from well center.

The Examiner has failed to provide a motivation or suggestion to combine the references, and instead, has impermissibly used the Applicant's disclosure as a template to piece together the prior art in order to render the Applicant's invention obvious. In her rejection, the Examiner states that the motivation to combine *Kelly* and *Swoboda* is "the desirability to be able to move a tong to any desired position on a drill rig thus facilitating easy connection/disconnection and movement of the tubulars around the rig," which is found in *Swoboda*, column 1, lines 56-68. However, the Examiner has misinterpreted the teachings of *Swoboda*. In the passage cited by the Examiner, *Swoboda* teaches the desire to have a mechanical gripping system adapted to restrain a pipe from swaying and is capable of guiding and moving the pipe to a plurality of locations. The passage makes no reference to a tong. In fact, *Swoboda* is silent as to the desirability to do anything with a tong. Moreover, tongs are not designed to move tubulars to various locations on the rig floor. Instead, the tong itself is moved to the tubular located proximate the wellbore to make up or break out the tubular. Therefore, *Swoboda* provides no motivation to combine its racking arm with a tong. Further, *Kelly*

provides a means for swinging the tong to the side along a fixed radius. (See, column 2, Ins. 56-60) There is no indication in *Kelly* that extension or retraction of the tong would serve any purpose. To the contrary, the *Kelly* specification indicates that the desired feature of moving the tong to and from a position aligned with the wellbore is fully achieved by the *Kelly* invention. (See, column 2, Ins. 57-59) Thus, *Kelly* has no need for a racking arm as taught by *Swoboda* to move the tong to multiple locations on the rig floor. Therefore, one of ordinary skill in the art would not be motivated to provide *Kelly's* tong with the racking arm of *Swoboda*. Combinations of references applied under 35 USC 103 are valid only when there is some teaching or suggestion in one or more of those references to combine the elements to do that which a later applicant claims as his invention. See Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 43 U.S.P.Q.2d 1294, 1297 (Fed. Cir. 1997). The absence of such a suggestion to combine the references is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997). Neither *Kelly* nor *Swoboda* contain the requisite suggestion to combine those references and the Applicant's pending claims are not obvious. The Examiner has improperly used hindsight to combine the references to support the obviousness rejection. See In re Rouffet, 149 F.3d 350, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)(hindsight is presumed when there is no motivation or suggestion to combine).

Thus, the references, neither alone nor in combination, teach, show, or suggest the inventions as recited in claims 1-24, 35-55, 57-62, and 64-69. Withdrawal of the rejection is respectfully requested.

Conclusion

In conclusion, the reference cited by the Examiner, does not teach, show, or suggest the apparatus or methods of the present invention.

Having addressed all issues set out in the office action, Applicant respectfully submits that claims 1-24, 35-55, 57-62, and 64-69 are in condition for allowance and respectfully requests that the same be allowed.

Respectfully submitted,



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